



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/791,961

03/03/2004

Allen W. Meyer

2920.AMEY.PT

5729

26986 7590 02/11/2008  
MORRISS OBRYANT COMPAGNI, P.C.  
734 EAST 200 SOUTH  
SALT LAKE CITY, UT 84102

EXAMINER

MCCORMICK, GABRIELLE A

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

02/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/791,961	<b>Applicant(s)</b> MEYER, ALLEN W.	
	<b>Examiner</b> Gabrielle McCormick	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☒ Claim(s) 11-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. This action is in reply to the application filed on March 3, 2004 and the preliminary amendment filed December 15, 2004.
2. Claims 1-31 are currently pending and have been examined.

### ***Drawings***

3. The replacement drawing for Figure 1, filed December 15, 2004, has been entered.

### ***Claim Objections***

4. Claims 11 and 12 are objected to for inaccurate use of trademarks and registrations. In claim 11, Excel® is not a trademarked, nor is Word or Project. In claim 12, Windows® is not trademarked.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1-12, 22, 25 and 29-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claims 1, 8 and 29 contain the term "optionally" which renders the claims indefinite because it is not clear whether the claim language that follows the term is meant to further limit the claim. As an example, in claim 1, notes are optionally printed. If the option is to **not** print the notes, are the notes moved to a repository and organized? And if they are not, the limitation of "optionally scanning...the organized notes" cannot be performed. Similar questions of definitiveness arise in

- claims 8 and 29. Claims 2-12 are dependent from claim 1 and are rejected through this dependency.
8. Claim 22 recites the limitation "the computer" in line 1. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 25 recites the limitation "the plurality of printers" in line 2, pg. 16. There is insufficient antecedent basis for this limitation in the claim.
10. Appropriate action is required.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. **Claims 1-4, 6-7, 10, 13, 15-16, 21-23, 25 and 29-31** are rejected under 35 U.S.C. 102(e) as being anticipated by Silverbrook et al. (US Pub. No. 2003/0106020, hereafter referred to as "Silverbrook").
13. **Claim 1:** Silverbrook discloses:
- *capturing discrete portions of information;* (P[0114]: Forms provide the data input mechanism)
  - *generating a note from each of the discrete portions of information, wherein each note includes visually perceptible note information and computer readable symbology of the note information;* (P[0110]: "Every time a participant adds a modification or a new piece of graphical information to the whiteboard the other participants are provided with an updated

- copy of the page" and P[0025]: forms had coded data printed on it which allows interaction with the computer system.)
- *optionally printing the notes;* (P[0032]: white board pages are printed)
  - *moving the notes to a selected repository;* (P[0023]: storage means for retaining a record of the note-taking session)
  - *organizing the notes in the selected repository to obtain organized notes* (P[0121]: whiteboard pages are uniquely identified by version number and P[0122]: a tree of versions is created for each white-board page, recording all the markups made)
  - *optionally scanning each of the computer readable symbologies on each of the organized notes to obtain note information;* (P[0065]: the coded data is sensed by an optically imaging pen and transmitted to the netpage system)
  - *placing the note information into one or more selected computer software applications.* (P[0016-0021]: the system exists as a computer application for note-taking)
14. **Claims 2-4:** Silverbrook discloses remote conferencing using whiteboard computer systems. (P[0012]).
15. **Claim 6:** Silverbrook discloses printed versions of pages (P[0142]: a full size copy of the page version is printed).
16. **Claim 7:** Silverbrook discloses session description, session purpose, duration and participant (user) fields (Fig. 18).
17. **Claim 10:** Silverbrook discloses version control as a means of ordering whiteboard pages. (P[0122]).
18. **Claims 13, 15, 16 and 21-23:** Silverbrook discloses remote conferencing over a computer network (P[0110]):
- *an input device and processor configured to execute a computer program* (P[0017] and P[0080]: "A netpage allows markings made with a netpage pen on its surface to be simultaneously captured and processed by the netpage system.")

- *receiving discrete portions of information and formatting each of the discrete portions of information as output, wherein each output includes visually perceptible version of each discrete portion of the information and a computer readable symbology of each discrete portion of the information; (P[0067]: “text written by hand on a netpage is automatically recognized and converted to computer text in the netpage system, allowing the forms to be filled in.” P[0071]: netpages are printed).*
19. **Claim 25:** Silverbrook discloses remote conferencing over a computer network in which the computers (P[0110]) in which the whiteboard pages are marked up (information is received) and re-distributed (output is generated) (P[0111]) and printed (P[0156]). The user writes on the whiteboard page using “captured digital ink” (P[0148]), thus output comprises *computer readable symbology*. The coded data is sensed by an optically imaging pen and transmitted to the netpage system. (P[0065]).
20. **Claim 29:** Silverbrook discloses:
- *capturing discrete portions of information entered by a touch screen on the computer with handwriting recognition software; (P[0017-0021])*
  - *generating a note from each of the discrete portions of information, wherein each note includes visually perceptible note information and computer readable symbology of the note information; (P[0148]: The user writes on the whiteboard page using “captured digital ink”, thus output comprises computer readable symbology and P[0025]: forms have coded data printed on it which allows interaction with the computer system.)*
  - *optionally printing the notes; (P[0032]: white board pages are printed)*
  - *moving the notes to a selected repository; (P[0023]: storage means for retaining a record of the note-taking session)*
  - *organizing the notes in the selected repository to obtain organized notes (P[0121]: whiteboard pages are uniquely identified by version number and P[0122]: a tree of versions is created for each white-board page, recording all the markups made)*

- *optionally scanning each of the computer readable symbologies on each of the organized notes to obtain note information;* (P[0065]: the coded data is sensed by an optically imaging pen and transmitted to the netpage system)
  - *placing the note information into one or more selected computer software applications.* (P[0016-0021]: the system exists as a computer application for note-taking)
21. **Claims 30 and 31:** Silverbrook discloses remote conferencing (P[0110]) and the Internet (P[0024]).

### ***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. **Claims 5, 17, 19, 20, 24 and 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al. (US Pub. No. 2003/0106020, hereafter referred to as "Silverbrook") in view of Coldiron ("Colorflex does on-demand, custom-labeling systems". Boulder County Business Report. Boulder: Nov. 15, 2002. Vol. 21, Iss. 24; pg. A11).
24. **Claims 5, 17, 19, 20, 24 and 26:** Silverbrook discloses the limitations of claims 1, 13 and 16, above. Silverbrook does not disclose printing labels or using barcoding.
25. Coldiron, however, discloses printing color-coded labels with bar codes to customize the labeling of files (P5) as a document management solution using electronic tracking software to control documents. (P6). Coldiron further discloses that barcoding links paper and electronic records. (P10) This linking inherently comprises a barcode scanner to read the barcode and import the information into a software application. Coldiron does not disclose two-dimensional barcoding,

but it is obvious to one of ordinary skill in the art to expand Coldiron to include 2-D barcoding as it is a major barcoding symbology.

26. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included labels and barcodes, as disclosed by Coldiron in the system disclosed by Silverbrook, for the motivation of providing a method of document management and control that links electronic and paper records. (Coldiron; P6 & 10).
27. **Claims 8, 9, 27 and 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al. (US Pub. No. 2003/0106020, hereafter referred to as "Silverbrook") in view of Jessup ("A quantum formula for improving meetings". The Journal for quality and Participation. Cincinnati: Jun. 1994. Vol. 17, Iss. 3; pg. 80).
28. **Claims 8, 9, 27 and 28:** Silverbrook discloses the limitations of claims 1 and 25. Silverbrook does not disclose flip charts or projectors.
29. Jessup, however, discloses using flip charts (pg.1; P10) and projectors (pg. 2; P4) in meetings. It is old and well known that flip charts can display information during a meeting by means such as affixing documents to the surface. It is also obvious to include projecting computer files via an overhead projector as this is old and well known technology for sharing electronic files necessary for discussion points during a meeting. By projecting the electronic file, all meeting attendees can simultaneously view the information and productively participate in the discussion.
30. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included flip carts and projectors, as disclosed by Jessup, in the system of Silverbrook for the motivation of providing an alternative means of collaboration for users in a meeting environment where they are not geographically remote from one another. (Silverbrook; P[0158]).



31. **Claims 11, 12 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al. (US Pub. No. 2003/0106020, hereafter referred to as "Silverbrook").
32. **Claims 11 and 12:** Silverbrook discloses electronic whiteboards can transmit notations to a computer for storage, display and printing by digitizing user input and storing it in a file for later retrieval and manipulation. The files can be copied to other applications. (P[0015]). Silverbrook does not disclose specific applications.
33. However, it is obvious to expand Silverbrook to include the specific Windows<sup>TM</sup> compatible applications of Excel<sup>TM</sup>, Word<sup>TM</sup> or Project<sup>TM</sup> because these are old and well known software applications for writing documents or creating spreadsheets. One would be motivated to expand Silverbrook to include a Word<sup>TM</sup> based document such as a meeting agenda.
34. **Claim 14:** Silverbrook discloses a messaging feature in P[0149], but does not disclose whether this is a wireless instant messaging capability. However, as wireless instant messaging is old and well known and Silverbrook's system already comprises wireless communication, it is obvious to expand Silverbrook to include wireless instant messaging as it is a convenient form of transmitting messages remotely.
35. **Claim 18** is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al. (US Pub. No. 2003/0106020, hereafter referred to as "Silverbrook") in view of Coldiron ("Colorflex does on-demand, custom-labeling systems". Boulder County Business Report. Boulder: Nov. 15, 2002. Vol. 21, Iss. 24; pg. A11) in view of Jessup ("A quantum formula for improving meetings". The Journal for quality and Participation. Cincinnati: Jun. 1994. Vol. 17, Iss. 3; pg. 80).
36. **Claim 18:** Silverbrook in view of Coldiron discloses the limitations of claim 17, above. Silverbrook does not disclose a flip chart.
37. Jessup, however, discloses using flip charts (pg.1; P10) in meetings. It is old and well known that flip charts can display information during a meeting by means such as affixing documents to the surface.

38. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included flip carts, as disclosed by Jessup, in the system of Silverbrook for the motivation of providing an alternative means of collaboration for users in a meeting environment where they are not geographically remote from one another. (Silverbrook; P[0158]).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is 571-270-1828. The examiner can normally be reached on Monday - Thursday (6:00- 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./  
Examiner, Art Unit 3629

/John G. Weiss/  
Supervisory Patent Examiner, Art Unit 3629